

REMARKS

This paper responds to the *Office Action* mailed on May 29, 2009. No claims are amended or added. Claim 15 was previously canceled. As a result, claims 1-14 remaining pending in this application.

§ 103 Rejection of the Claims

Claims 1-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,572,442 to Schulhof et al. (*Schulhof*) in view of U.S. Patent No. 5,956,716 to Kenner et al. (*Kenner*) and further in view of U.S. Patent No. 5,566,175 to *Davis*. However, in presenting the arguments, the Examiner referred to *Redmond* (U.S. Patent No. 7,301,944) instead of *Davis*. As such, Applicants assume that the Examiner is rejecting claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over *Schulhof* in view of *Kenner* and further in view of *Redmond*. Since a *prima facie* case of obviousness has not been properly established, Applicants respectfully traverse the rejection.

The U.S. Supreme Court decision of *KSR v. Teleflex* provides a tripartite test to evaluate obviousness.

The rationale to support a conclusion that a claim would have been obvious is that ***all the claimed elements were known in the prior art*** and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. (*See KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007)), *see also* MPEP § 2143. Emphasis added.)

Applicants will show that the cited references, either singly or in combination, neither teach nor suggest all claimed elements of Applicants' claims.

Claim 1 recites, in part,

creating a request count for each content item of said plurality of content items based on said requests received;

sorting said requests using said request count;

determining an associated retransmit rate for each of said content items, said **content items with a higher request count receiving a higher associated retransmission rate** than content items with a lower request count; and

repeatedly broadcasting the content items **at said associated retransmit rate**.

Each of the other independent claims, claims 5 and 9, contain similar limitations as recited by claim 1.

In rejecting claim 1, the Examiner relied on *Schulhof* for receiving requests for a plurality of content items and for creating a list of said content items. However, the Examiner acknowledged that *Schulhof* did not disclose any other elements of claim 1. Consequently, the Examiner relied on *Kenner* to disclose “creating a request count for each content item of said plurality of content items based on said requests received” and “sorting said requests using said request count” (citing col. 5, lines 32-38 and col. 9, lines 55-67 of *Kenner*).

A closer reading of *Kenner* indicates that requests are not sorted, but that content may be duplicated and stored based on frequency of the request for the content. Specifically, “PIM records how often particular video clips are requested, and from this information determines whether those clips should be duplicated at particular local SRUs for ready display.” *Kenner*, col. 5, lines 32-35. *Kenner* further recites

[a] second function of the local search and update logic is to identify and track the most frequently requested audio-visual clips. These video clips are **identified for continued storage** within the local SRU . . . [ensuring that] only the most heavily used video clips are stored . . . [W]hen a video clip with higher usage than the least used locally stored clip is identified, the least used clip is replaced by the higher usage clip within the local SRU.
Kenner, col. 9, lines 55-64. (emphasis added)

Clearly, these cited passages from *Kenner* do not disclose “sorting said requests using said request count.”

The Examiner further contended that the elements “content items with a higher request count” and “content items with a lower request count” are disclosed in *Kenner*. Applicants respectfully remind the Examiner that USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole

must be considered. *See, e.g., Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981). In the present case, the Examiner has separated out content items with higher and lower request counts from an element of claim 1, and merely pointed to a reference that discusses video clips with higher usage than a least used locally stored clip. Clearly, the Examiner is evaluating elements in isolation and not considering the claim as a whole.

As further proof, the Examiner found the combination of *Schulhof* and *Kenner* did “not explicitly disclose *determining an associated retransmit rate for each of said content items*, [that the content items with a higher request count] *receiving a higher associated retransmission rate and repeatedly broadcasting the content items at said associated retransmit rate*,” but found *Redmond* disclosed this limitation. *Office Action* at 3 (emphasis in original). As is clearly evident by the brackets removing the limitation “that the content items with a higher request count” (*see Office Action* at 3), the Examiner is evaluating this claim limitation in isolation. Further, by removing a portion of the claimed element, the Examiner has failed to consider all elements of the claim.

With respect to *Redmond*, the Examiner stated that “Redmond discloses a server/client media file distribution system wherein a media file server is adapted to monitor incoming user request messages and determine an overall throughput value based on the current user’s transmission speed which can be automatically adjusted and used to optimally transmit a given media file.” *Office Action* at 3. However, claim 1 is not directed to adjusting a transmission speed. To the contrary, claim 1 recites “content items with a higher request count receiving a higher associated retransmission rate than content items with a lower request count; and repeatedly broadcasting the content items at said associated retransmit rate.” A retransmit rate (e.g., a frequency of retransmission) is not the same as a transmission speed.

Additionally, the cited portion of *Redmond* is directed to a “traffic director [which] monitors the transmission protocol and transmission speed of each client, and uses this information to optimally transmit a given media file to one or more clients.” *Redmond*, col.5, lines 32-35. Specifically, “the transmission speed of the server can be automatically adjusted based on the average throughput speed of the users currently in communication with the server.” *Redmond*, col. 5, lines 52-55. Thus, the cited portion of *Redmond* discloses transmission based on speed and protocol and not based on a request count.

Since Applicants have shown that not all the claimed elements were known as required by *KSR*, either by *Schulhof* singly or in any combination with *Kenner* and *Redmond*, Applicants respectfully request the Examiner withdraw the rejection under 35 U.S.C. §103 with regard to independent claims 1, 5, and 9.

Furthermore, since claims 2-4, 6-8, and 10-14 depend from claims 1, 5, and 9, respectively, these claims are allowable for at least the same reasons as those provided with respect to their respective independent, base claims. These dependent claims each may contain additional patentable subject matter.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4040 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 8/31/09

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 31 day of August, 2009.

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